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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,556	02/07/2002	Richard A. Goldsby	50263/003002	4316
21559	7590	08/19/2004	EXAMINER	
CLARK & ELBING LLP 101 FEDERAL STREET BOSTON, MA 02110			CROUCH, DEBORAH	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

34.

Office Action Summary

Application No.

10/072,556

Applicant(s)

GOLDSBY ET AL.

Examiner

Deborah Crouch, Ph.D.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1632

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 and 8-14, drawn to a method for producing a cloned ungulate wherein expression of both copies of a gene for Iga has been knocked out, classified in class 800, subclass 24.
- II. Claims 1-6 and 8-14, drawn to a method for producing a cloned ungulate wherein expression of both copies of a gene for E2A has been knocked out, classified in class 800, subclass 24.
- III. Claims 1-6 and 8-14, drawn to a method for producing a cloned ungulate wherein expression of both copies of a gene for EBF has been knocked out, classified in class 800, subclass 24.
- IV. Claims 1-6 and 8-14, drawn to a method for producing a cloned ungulate wherein expression of both copies of a gene for BSAP has been knocked out, classified in class 800, subclass 24.
- V. Claims 1-22, drawn to a method for producing a cloned ungulate wherein expression of both copies of a gene for rag-1, rag-2 or both rag-1 and rag-2 has been knocked out, a transgenic ungulate and methods of making nonbovine antibodies, classified in class 800, subclass 24.
- VI. Claims 23-26, drawn to a method of producing hybridomas, classified in class 435, subclass 70.21.
- VII. Claims 27 and 28, drawn to a method of expanding human B cells, classified in class 424, subclass 93.2.
- VIII. Claims 29 and 30, drawn to a method for maintaining desired tissues and organs or cells in vivo, classified in class 424, subclass 93.2.

Art Unit: 1632

Inventions I-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

Each of inventions I-V are mutually exclusive and independent methods as each method requires materially different and separate targeting constructs for knocking out expression. Further, none of inventions I-V are needed to implement any of the other inventions.

Each of inventions VI-VIII are mutually exclusive and independent methods. None of the methods are required for the implementation each other.

The inventions are distinct, each from the other because:

Each of Inventions I-V and each of inventions VI-VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the ungulate can be used to produce antibodies.

Because inventions I-V and VI-VIII are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Groups I-V is not required for Groups VI-VIII, and for Group VI is not required for Groups VII and VIII, restriction for examination purposes as indicated is proper.

Art Unit: 1632

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Crouch, Ph.D. whose telephone number is 571-272-0727. The examiner can normally be reached on M-Th, 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 571-272-0408. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Deborah Crouch, Ph.D.
Primary Examiner
Art Unit 1632

August 16, 2004